

REMARKS

In response to the office action mailed January 5, 2007, Applicants submit the remarks provided below. Claims 1-4, 6-18, 20-34, 36, 43, and 73-87 are presented for examination.

Claims 1-4, 6-18, 20-34, 36, 43 and 73-87 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Vigil et al., U.S. Patent No. 5,336,234 ("the Vigil patent") in view of Chen et al., U.S. Patent No. 6,905,743 ("the Chen patent"). However, the Chen patent is disqualified as prior art under 35 U.S.C. § 103(c) because the Chen patent and the pending application (Serial No. 10/083,926) were commonly owned or subject to obligation of assignment to the same entity at the time the claimed invention was made.

Moreover, a person of ordinary skill in the art would not have been motivated to combine the teachings of the Vigil patent and the Chen patent in a manner to produce medical devices including a balloon having a first material and a second material (or striped portion) encapsulated by the first material and a cutting element carried by (or attached to) the balloon over the second material (or striped portion), as recited in Applicants' claims. The Examiner contended that it would have been obvious to a person of ordinary skill in the art to modify Vigil's balloon in view of the Chen patent to place Vigil's reinforcement strips within the wall of Vigil's balloon in order to reinforce the balloon, enhance the radial expansion of the balloon, and limit longitudinal growing during balloon inflation. However, the Chen patent describes a stent delivery balloon that includes a fibril structure that can limit longitudinal and/or radial expansion of the balloon when inflated and makes clear that this configuration helps to improve stent delivery. *See, e.g.*, the Chen patent, col. 2, lines 5-16; col. 1, lines 28-47. The Vigil patent, in contrast, is directed to a balloon catheter 10 including a balloon 12 having cutting elements 19 mounted on its outer surface. *See, e.g.*, the Vigil patent, col. 3, lines 58-64. Vigil explains that oscillatory motion can be imparted to cutting elements 19 via catheter tube 14 and balloon 12 to incise the surrounding tissue during use. *See, e.g., id.*, col. 4, lines 27-30. Vigil makes no mention that his balloon, which includes cutting elements mounted on its outer surface, can be used to deliver and/or deploy a stent. Moreover, there is no indication in the Vigil patent that limiting longitudinal and/or radial expansion of Vigil's balloon would provide any benefit whatsoever. Therefore, in

view of the Chen patent, a person of ordinary skill in the art would not have been motivated to place reinforcement strips within the wall of Vigil's balloon, an arrangement that the Chen patent describes as improving stent delivery.

The Examiner also contended that, in view of the Chen patent, it would have been obvious to a person of ordinary skill in the art to place Vigil's cutting elements over the reinforcing members within the wall of Vigil's balloon so that the portion of the balloon including the reinforcing member would provided better support for the cutting element. However, the Examiner set forth no evidence to support this contention. And there is no indication in either the Vigil patent or the Chen patent that such an arrangement would be beneficial. As discussed above, a person of ordinary skill in the art would not even have been motivated to place reinforcement strips within the wall of Vigil's balloon, let alone motivated to place the reinforcement strips within the wall of Vigil's balloon in a manner such that Vigil's cutting elements are located over the reinforcement strips. Applicants submit that the Examiner, impermissibly using hindsight, relied on Applicants' own specification to make the above-noted combination.

In view of the foregoing remarks, Applicants request reconsideration and withdrawal of the rejection of claims 1-4, 6-18, 20-34, 36, 43 and 73-87.

The Examiner also cited Chen et al., U.S. Patent Application Publication No. 2001/0043998 ("the Chen publication"). However, for reasons similar to those discussed above, a person of ordinary skill in the art would not have been motivated to combine the teachings of the Vigil patent and the Chen publication in a manner to produce medical devices including a balloon having a first material and a second material (or striped portion) encapsulated by the first material and a cutting element carried by (or attached to) the balloon over the second material (or striped portion), as recited in Applicants' claims.

Applicants submit that all claims presented for examination are allowable over the cited references, which action is requested.

Please apply any charges or credits to deposit account 06-1050, referencing Attorney Docket No. 10527-395001.

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Respectfully submitted,

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